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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,955	03/11/2004	Timothy D. Killinger	29618/39225D	7721
4743 7590 01/15/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606				
EXAMINER NEWTON, JARED W				
ART UNIT 3693		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,955

**Applicant(s)**

KILLINGER ET AL.

**Examiner**

JARED W. NEWTON

**Art Unit**

3693

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This non-final rejection is in reply to the remarks filed October 30, 2007, by which claims 1, 9 and 17 were amended. Claims 1, 2, 4-10 and 12-20 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the following recitations were not described in the specification as originally filed:

- “wherein the file support structure is configured such that a file disposed on the file suspension device is completely disposed between outer surfaces of the first and second panels” (claim 1, lines 19-21);

The new subject matter should be canceled from the claims.

***Claim Rejections - 35 USC § 102***

Claims 1-8 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 4,505,388 to Solomon.

In regard to claims 1 and 17, Solomon discloses an expandable filing system comprising: an exterior shell 10 having an outer surface (see FIGS. 1 and 2); an openable panel 16 defining part of the exterior shell, the openable panel having a bottom edge 32, a forward facing surface, and a rear facing surface (see FIG. 2), the openable panel 16 being pivotal about the bottom edge 32 outward from the exterior shell between a retracted condition (see FIG. 2) at which the forward facing surface is generally flush with the outer surface of the exterior shell and an open condition 34 (see FIG. 2, phantom) away from the outer surface of the exterior shell; and

a file support structure (see Abstract, In. 14-15) capable of suspending a file at any position along its length when the openable panel is in the open condition, said structure having a file storage area, an open top for insertion, access to, and removal of files from the file storage area, a pair of panels 66 extending rearward from the rear facing surface of the openable panel defining in part the file storage area, and a file suspension device (upper edges of panels 66—see col. 2, In. 55-65) provided to

suspend files completely within the file storage area, the file support structure disposed adjacent to the rear facing surface of the openable panel and being movable in concert with the openable panel (see FIG. 2), wherein the open top is accessible when the openable panel is in the open condition (see FIG. 2, phantom) and wherein the file support structure is disposed within the exterior shell when the openable panel is in the retracted condition (see FIG. 2). Solomon further discloses said openable panel as pivotable between the open condition and the retracted condition without moving top panel 22 (see FIG. 2).

Solomon further discloses the file support structure as configured such that a file disposed on the file suspension device is completely disposed between outer surfaces of the first and second panels (see FIG. 3).

In regard to claim 2, Solomon further discloses the exterior shell comprising: a pair of opposed side panels 12 and 14; and a front panel 16 defined at least in part by the openable panel (see FIG. 2).

In regard to claims 3 and 18, Solomon further discloses the file support structure comprising: a pair of suspension surfaces (upper edges of panels 66) on laterally spaced apart and opposed side of the open top (see FIG. 2).

In regard to claim 4, Solomon further discloses the pair of suspension surfaces arranged to present files suspended in the file storage area in a forwardly and downward cascading arrangement (see FIG. 2, phantom).

In regard to claims 5 and 19, Solomon further discloses each pair of suspension surfaces as arched (see FIG. 2).

In regard to claims 6 and 7, Solomon further discloses the exterior shell comprising a top panel 22 providing a generally horizontal support surface in the form of a table when the openable panel is in the retracted position (see FIG. 2).

In regard to claim 8, Solomon further discloses the exterior shell and the openable panel 16 as combinable to form a configuration that hides the file storage area of the storage device when the openable panel is in the closed condition (see FIG. 2).

In regard to claim 20, said suspension surfaces extend continuously from the openable panel to a rear end (see FIG. 2).

### ***Claim Rejections - 35 USC § 103***

Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,505,388 to Solomon as applied to claims 1-8 and 17-20 above, and further in view of US Patent No. 4,666,047 to Fletcher.

Solomon discloses the expandable filing system as set forth above, including all of the limitations of claims 10-16. Solomon does not specifically set forth the file suspension supports (shown as the upper edges of panels 66) as having a series of notches. Fletcher discloses a hanger support for filing cabinets comprising: frame members 26 and 28 for supporting stationary rails 18 and 20, said rails adapted for receiving suspension rails 50 and 52 for supporting file hangers (see FIGS. 1 and 6). Fletcher further discloses each of said stationary rails comprising a plurality of notches 44 (see FIG. 1), wherein said notches retain said suspension rails, and thus said file hangers. The Solomon and Fletcher references are analogous art because they are

from the same field of endeavor—file suspension devices. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the notches as disclosed by Fletcher on the upper edges of the panels as disclosed by Solomon. The motivation would have been that as set forth by Fletcher—to maintain files in a spaced relationship (see Fletcher, col. 4, ln. 4-15). It would be an obvious and successful improvement to the upper shoulders of the panels 66 of Solomon, to provide said shoulders with evenly spaced notches, in order to maintain files in an evenly spaced and orderly manner.

### ***Response to Arguments***

In view of the Amendments filed October 30, 2007, the rejection of claims 9, 10 and 12-20 under 35 U.S.C. §112 1<sup>st</sup> Paragraph set forth in the Office Action mailed September 4, 2007 is hereby withdrawn.

Applicant's arguments filed October 30, 2004 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1, 2 and 4-8 under 35 U.S.C. §112 1<sup>st</sup> Paragraph, the Examiner maintains that the noted recitation of claim 1 is not supported by the specification as originally filed. Applicant contends the following: "The file suspension devices are located within a storage area. Furthermore, the storage area is defined as being located between two wedge-shaped panels. Thus, the file suspension devices must be positioned between the two wedge-shaped panels ... Because the file suspension device 50 is located between the panels 70, the entire file folder must also

be located between the panels 70." (Remarks, page 8). The Examiner does not refute the description of the suspension devices. However, the rejected claim limitation is drawn to the disposition of the file itself—not that of the suspension device. The limitation recites as follows: "wherein the file support structure is configured such that a file disposed on the file suspension device is completely disposed between outer surfaces of the first and second panels" (see claim 1, lines 19-21). The specification defines the files as follows: "Thus, each folder 52 will typically have four laterally extending hooks. These hooks typically rest on and bear against a portion of a suspension device, such as the suspension surfaces 54 in this example" (see [0033]). If the hooks are part of the file as the recitation suggests, and the hooks rest on the suspension surfaces 54, then the file cannot be said to lie between the outer surfaces of the first and second panels. This interpretation comports with Figure 3 of the instant application, which shows the "hooks" as resting on the suspension surface 54. Nothing in the specification suggests that the "hooks" are not part of "file," and therefore the noted claim limitation is deemed new subject matter.

With respect to the rejection of claims 1-8 and 17-20 under 35 U.S.C. §102(b) as anticipated by US Patent No. 4,505,388 to Solomon, Applicant contends the following: "the hangar (sic) portion of the hanging file [of Solomon] rests on top of, and hangs over, the side panels resulting in a portion of the file being disposed outside the storage space and not between the side panels." (Remarks, page 9, emphasis omitted). The Examiner agrees that as best shown in Figure 3 of Solomon, the files are supported by



hooks, wherein a portion of the hooks lies outside of the outer surface of the panels 66. However, the Examiner has assigned the broadest reasonable interpretation to the terms "file" (claim 1) and "folder" (claim 17), to correspond to the file folders 42 taught by Solomon, and not to the hooks that support them. This interpretation corresponds to the language of claim 9, which recites: "a file folder with hooks, the hooks being disposed on the file suspension device, and the folder being completely disposed between outer surfaces of the first and second panels" (claim 9, lines 17-18). Under this interpretation, Solomon shows the file/folder disposed completely between the outer surfaces of panels 66 (see FIG. 3).

With respect to claims 17-20, Applicant recites the following: "Solomon fails to disclose or suggest an openable panel that is pivotable without opening a top panel" (remarks, page 10). To the contrary, as clearly shown in Figure 2 of Solomon, when top panel 22 is fully opened as shown by phantom image 28, the openable panel is pivotable about hinge 30. Therefore, if top panel 22 is already in the position indicated by reference character 28, then the openable panel is pivotable without opening the top panel—the top panel is already open. In other words, when the top panel 22 is in the position indicated by 28, the openable panel operates independently of top panel, and thus meets the limitations of the claims.

With respect to the rejection of claims 9-16 under 35 U.S.C. §103(a) as obvious over Solomon in view of US Patent No. 4,666,047 to Fletcher, the Applicant has based his arguments on the alleged deficiencies of Solomon; however, since those arguments

have been refuted as set forth above, the rejections based on Solomon in view of Fletcher are upheld.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JARED W. NEWTON whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/James A. Kramer/

Supervisory Patent Examiner, Art Unit 3693